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23644 7590 04/04/2011 BARNES & THORNBURG LLP P.O. Box 2786 CHICAGO, IL 60690-2786				
EXAMINER				
RAPILLO, KRISTINE K				
ART UNIT		PAPER NUMBER		
3626				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary

Application No.

10/675,128

Applicant(s)

MILOSAVLJEVIC, NADA

Examiner

KRISTINE K. RAPILLO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 2-6, 8-21, 23, 26-28 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 22, 24-25, 29 - 34, and 36 - 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/30/2003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Request for Continued Examination (RCE) filed September 16, 2010. Claims 1, 22, and 32 have been amended. Claim 35 is cancelled (claims 2 – 6, 8 – 21, 23, and 26 - 28 were previously cancelled). Claims 36 – 45 are new. Claims 1, 7, 22, 24 – 25, 29 – 34, and 36 - 45 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2010 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 7, and 32 - 34 are rejected under 35 U.S.C. 101 because Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 1, 7, and 32 - 34 are held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. § 101. In particular, the rationale for finding that claims 1, 7, and 32 - 34 are directed toward non-statutory subject matter include no recitation of a machine or transformation, either express or inherent. See *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 7, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell, herein after Campbell (U.S. Patent Number 6,047,259) in view of Iliff (U.S. Patent. No. 6,468,210) further in view of Tetrault (U.S. Publication Number 2002/0172809 A1).

With regard to claim 1 (Currently amended), Campbell teaches a method for facilitating the evaluation, diagnosis and treatment of a patient (column 2, lines 2 – 4), comprising the steps of:

(a) conducting a preliminary physical examination of the patient (column 7, lines 31 – 41) and making a preliminary diagnosis based on the preliminary physical examination that patient has a particular medical disorder (column 5, lines 48 – 51 and column 12, lines 48 – 55) where Campbell discloses a rule out list and tentative diagnosis;

(b) after the performance of step (a) obtaining a paper template having only one sheet of paper, the one sheet of paper having preprinted information listing signs or symptoms that might be exhibited by one afflicted with the particular medical disorder (column 4, lines 56 – 60) where a user can enter information through a keyboard and other input devices

and information listing other medical disorders that might be confused with the particular medical disorder (Figure 9; column 7, lines 42 – 48; and column 16, line 66 through column 17, line 22) where a rule out list is displayed (the rule out list consists of medical disorders with the same or similar signs or symptoms);

(c) after the performance of step (b) consulting the paper template for information prompting the user to further examine the patient for the signs or symptoms listed on the paper template (Figure 9;

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column 16, line 33 through column 17, line 37). Campbell does not disclose a paper template, however, this feature is disclosed by Tetrault and discussed below.

Iliff teaches a method comprising: (d) after the performance of step (c), conducting a further examination of the patient to determine whether the patient is exhibiting the signs or symptoms listed on the paper template and entering onto the paper template hand written information identifying those of the one or more signs or symptoms listed on the paper template that are exhibited by the patient (Figures 31, 32a, and 34; column 8, lines 5 – 19 where medical disorders are further defined by more specific symptoms). Iliff does not disclose a paper template, however, this feature is disclosed by Tetrault and discussed below.

Tetrault discloses a preprinted paper template which may be re-used time and again (paragraphs 13 – 17).

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Campbell in view of Iliff, further in view of Tetrault.

Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol.

Iliff is directed to a structure based processing which includes a method of diagnosing diseases that works by arranging diseases, symptoms, and questions into a set of related disease, symptom, and question structures, such as objects or lists.

Tetrault is directed to a method for producing a reusable plastic paper which is disposed a printed template, comprising an opaque plastic layer, printing on one or both surfaces, and sandwiching the printed layer between a first clear layer and a second clear layer.

It would have been obvious to one of ordinary skill in the art to include in the system of diagnosing a disease of Campbell the ability to generate lists of related symptoms as taught by Iliff with the re-usable template disclosed by Tetrault since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

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separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With regard to claim 7 (Previously Presented), Campbell, Iliff, and Tetrault teach the method of claim 1.

Iliff teaches a method further comprising the step of transmitting the information about the particular medical disorder, the predefined signs or symptoms exhibited by the patient and the patient data to another user or to the patient's medical record (column 5, lines 35 – 43).

The motivation to combine the teachings of Campbell and Iliff is discussed in the rejection of claim 1, and incorporated herein.

With regard to claim 32 (Currently Amended), Campbell, Iliff, and Tetrault teach the method of claim 1.

Iliff teaches a method further comprising the step of:

(e) consulting the paper template for information prompting the user to conduct a differential diagnosis of the patient based on the information identifying other medical disorders that might be confused with the particular medical disorder (column 6, lines 11 – 23; column 49, lines 55 – 65; and, column 51, lines 2 – 15 where a differential diagnosis is performed to further identify the medical disorder of the patient).

Tetrault discloses a paper template (paragraphs 13 – 17).

The motivation to combine the teachings of Campbell, Iliff, and Tetrault is discussed in the rejection of claim 1, and incorporated herein.

With regard to claim 33 (Currently Amended), Campbell, Iliff, and Tetrault teach the method of claim 32. Campbell teaches a method further comprising the steps of:

(f) consulting the paper template for information prompting the user to conduct a work up of said patient, the work up comprising one or more predefined elements based on the information identifying the

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particular medical disorder (Figure 10 and column 17, lines 45 – 52 where recommended therapies are displayed based on the medical disorder selected).

Iliff discloses a method further comprising the step of

(g) entering onto the paper template hand written information identifying those of the one or more predefined work up elements conducted on the patient (column 5, lines 10 – 21; column 9, lines 22 – 38; and column 10, lines 35 – 43 where laboratory tests and images can be performed to assist in the diagnosis of a medical disorder).

Tetrault discloses a paper template (paragraphs 13 – 17).

The motivation to combine the teachings of Campbell, Iliff, and Tetrault is discussed in the rejection of claim 1, and incorporated herein.

With regard to claim 34 (Currently Amended), Campbell, Iliff, and Tetrault teach the method of claim 33. Campbell teaches a method further comprising the steps of:

(h) consulting the paper template for information prompting the user to recommend a treatment plan for the patient (column 7, lines 42 – 56 where a treatment protocol is recommended based on a tentative diagnosis), the treatment plan comprising one or more predefined elements based on the information identifying the particular medical disorder (column 17, lines 53 – 60); and

(i) entering onto the paper template hand written information identifying those of the one or more predefined treatment plan elements recommended for the patient (column 2, lines 4 – 31).

Tetrault discloses a paper template (paragraphs 13 – 17).

The motivation to combine the teachings of Campbell, Iliff, and Tetrault is discussed in the rejection of claim 1, and incorporated herein.

7. Claims 22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell, herein after Campbell (U.S. Patent Number 6,047,259) in view of Dahlin et al., herein after Dahlin (U.S. Pub. No. 2004/0078215 A1).

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With regard to claim 22 (Currently amended), Campbell teaches an apparatus for use in connection with providing health care to a patient suspected of having a medical disorder, comprising:

Preprinted information prompting the user to further examine the patient for one or more predefined signs and/or symptoms associated with the respective medical disorder (Figure 9 and column 2, lines 4 – 31) where prompts or reminders are displayed to guide a user through a medical exam to aid in selection of a tentative diagnosis (information may be preprinted on the computer screen as well as a sheet of paper) – preprinted information can be displayed on a computer monitor as well as on a sheet of paper;

Preprinted information prompting the user to recommend one or more predefined treatments that could be administered to treat the respective medical disorder (column 17, lines 46 – 55) where a treatment protocol is recommended to treat a tentative diagnosis;

at least one field for entry of patient data (Figure 4 and column 12, lines 13 – 18);

the user's observation that the patient exhibits one or more of the predefined signs and/or symptoms associated with the respective medical disorder (Figure 9; column 2, lines 4 – 31) where a user makes observations based on the examination and compares to predetermined observations;

the user's opinion that one or more of the predefined tests should be conducted to confirm that the patient is afflicted by the respective medical disorder (column 18, line 61 through column 19, line 52) where a therapy (treatment) screen is displayed which indicates products (i.e. medications) and services (interpreted as laboratory work or radiological images) to be performed; and

the user's opinion that one or more of the predefined treatments should be administered to treat the patient (column 18, line 61 through column 19, line 52) where a user can select a particular therapy to treat a patient.

Dahlin teaches an apparatus comprising:

a set of templates (Figures 3 – 19), each of the templates directed to a different medical disorder (paragraphs [0119] and [0124] where Dahlin discloses complain specific templates, thus different templates for different disorders), one of which medical disorders the patient has been preliminarily diagnosed as being afflicted with based on a preliminary physical examination of the patient (as taught by

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Campbell in figures 9 and 10 where different medical disorders are illustrated), each of the templates provided with:

Preprinted information prompting the user to conduct one or more predefined tests that could be used to determine the presence or severity of the respective medical disorder (paragraphs [0020], and [0093]);

wherein each of said templates is adapted for annotation by a user to indicate (paragraph [0105]):

Claim 22 is rejected under 35 U.S.C. 103 as being unpatentable over Campbell in view of Iliff, further in view of Dahlin.

Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol.

Dahlin is directed to a system and method for efficiently documenting medical findings that consist of both a problem and a location on or in the body, and further provides a method for documenting multiple problems in related body locations using a template of the human body on a computer.

It would have been obvious to one of ordinary skill in the art to include in the system of diagnosing a disease of Campbell the ability to use templates to locate the medical problems as taught by Dahlin since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Template claim 36 repeats the subject matter of claim 22. As the underlying process of claim 22 has been shown to be fully disclosed by the teachings of Campbell and Dahlin in the above rejections of claim 22; as such, this limitation (36) is rejected for the same reasons given above for claim 22 and incorporated herein.

8. Claims 24 – 25, 29 – 31, 38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell, herein after Campbell (U.S. Patent Number 6,047,259) in view of Dahlin et al., herein

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after Dahlin (U.S. Pub. No. 2004/0078215 A1) further in view of Chin et al., hereinafter Chin (U.S. Patent Number 6,632,042).

In regard to claim 24 (Previously Presented), Campbell and Dahlin teach the apparatus of claim 22.

Chin teaches an apparatus wherein one of the templates can be removed from the set of templates without damaging the remaining templates (column 8, lines 8 – 14 and column 10, lines 51 – 56) where the templates enclosed in transparent plastic can be assembled in a 3 ring binder or other binding system.

Claim 24 is rejected under 35 U.S.C. 103 as being unpatentable over Campbell in view of Dahlin further in view of Chin.

Campbell is directed to a

software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol.

Dahlin is directed to a system and method for efficiently documenting medical findings that consist of both a problem and a location on or in the body, and further provides a method for documenting multiple problems in related body locations using a template of the human body on a computer.

Chin is directed to a printed sheet protector system with binders.

It would have been obvious to one of ordinary skill in the art to include in the system of diagnosing a disease of Campbell the ability to use templates to locate the medical problems as taught by Dahlin since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With regard to claim 25 (Previously Presented), Campbell, Dahlin, and Chin teach the apparatus of claim 22. Dahlin teaches an apparatus wherein each of the templates is printed (paragraph [0124]), however, Dahlin fails to teach where the template is printed on paper encased in transparent plastic.

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Chin teaches an apparatus wherein each of said template is printed on paper encased within transparent plastic (Chin: column 3, lines 24 – 28).

The motivation to combine the teachings of Campbell, Dahlin, and Chin is discussed in the rejection of claim 22, and incorporated herein.

With regard to claim 29 (Previously Presented), Campbell, Dahlin, and Chin teach the apparatus of claim 22.

Chin teaches an apparatus wherein the set of templates is bound into a handbook (column 8, lines 8 – 14 and column 10, lines 51 – 56) where the templates enclosed in transparent plastic can be assembled in a 3 ring binder or other binding system.

The motivation to combine the teachings of Campbell, Dahlin, and Chin is discussed in the rejection of claim 22, and incorporated herein.

With regard to claim 30 (Previously Presented), Campbell, Dahlin, and Chin teach the apparatus of claim 22. Campbell teaches an apparatus wherein the apparatus further comprises one or more templates including reference data comprising normal values or value ranges for the one or more tests (Figure 5) where a user can indicate, for example, whether a patients temperature is normal based on the range of subnormal through elevated.

With regard to claim 31 (Previously Presented), Campbell, Dahlin, and Chin teach the apparatus of claim 22.

Dahlin teaches an apparatus wherein the apparatus further comprises a vision chart (paragraphs [0118], [0119], and [0124]). Although Dahlin does not explicitly disclose a vision chart, it would be obvious to include a vision chart when a patient's chief complaint involves the eyes (i.e. blurred vision).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include an apparatus wherein the apparatus further comprises a vision chart as taught by Dahlin, within the method of Campbell and Chin, with the motivation of providing an electronic

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system for documenting the results of a physical examination and outputting a plurality of medical problems based on the examination (paragraph [0019]).

Template claims 38 and 44 repeats the subject matter of claim 25 and 24, respectively. As the underlying process of claims 25 and 24 have been shown to be fully disclosed by the teachings of Campbell, Dahlin, and Chin in the above rejections of claims 25 and 24; as such, these limitations (38 and 44) are rejected for the same reasons given above for claim 25 and incorporated herein.

9. Claims 37, 39 – 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell, herein after Campbell (U.S. Patent Number 6,047,259) in view of Dahlin et al., herein after Dahlin (U.S. Pub. No. 2004/0078215 A1) further in view of Tetrault (U.S. Publication Number 2002/0172809 A1).

With regard to claim 37 (new), Campbell, Dahlin, and Tetrault teach the template of claim 36.

Tetrault teaches a template wherein the paper template is of a size capable of being easily transported in a pocket of a typical laboratory coat of a health care practitioner (paragraphs 6, 7, 35, and 48).

Claim 37 is rejected under 35 U.S.C. 103 as being unpatentable over Campbell in view of Iliff, further in view of Tetrault.

Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol.

Dahlin is directed to a system and method for efficiently documenting medical findings that consist of both a problem and a location on or in the body, and further provides a method for documenting multiple problems in related body locations using a template of the human body on a computer.

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Tetrault is directed to a method for producing a reusable plastic paper which is disposed a printed template, comprising an opaque plastic layer, printing on one or both surfaces, and sandwiching the printed layer between a first clear layer and a second clear layer.

It would have been obvious to one of ordinary skill in the art to include in the system of diagnosing a disease of Campbell the ability to use templates to locate the medical problems as taught by Dahlin with the re-usable template disclosed by Tetrault since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With regard to claim 39 (new), Campbell, Dahlin, and Tetrault teach the template of claim 38.

Tetrault teaches a template wherein the transparent plastic cover is adapted for being marked and having the marks wiped clean (paragraphs 13 – 17).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 40 (new), Campbell, Dahlin, and Tetrault teach the template of claim 36.

Tetrault teaches a template wherein the paper template includes a title of the medical disorder, a field for patient identification data, descriptive information about the medical disorder relating to the etiology of the disorder, a list of signs and symptoms of the disorder; differential diagnoses for the disorder; a list of tests used to confirm or evaluate the disorder; a list of treatments for the disorder, and information of particular note about the disorder (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the patient identification, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035 **, *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

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The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 41 (new), Campbell, Dahlin, and Tetrault teach the template of claim 36.

Tetrault teaches a template wherein the paper template is a single page with a title of the medical disorder, a field for patient identification data, descriptive information about the medical disorder relating to the etiology of the disorder, a list of signs and symptoms of the disorder, differential diagnoses for the disorder, a list of treatments for the disorder and information of particular note about the disorder on one side of the page and with the opposite side of the page including a field for recording laboratory test results and signs determined from a physical examination of the patient, a field for recording medications that the patient is taking or receiving, and a field for recording additional notes, comments, or information relating to the disorder or the patient (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the medical disorder, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 42 (new), Campbell, Dahlin, and Tetrault teach the template of claim 41.

Tetrault teaches a template wherein the opposite side also illustrates separation of signs and symptoms into groups that commonly occur together or are associated with a particular form of the disorder (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the separation of signs and symptoms, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious

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functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 43 (new), Campbell, Dahlin, and Tetrault teach the template of claim 41.

Tetrault teaches a template wherein the one side includes a section for listing follow-up procedures used for patients with the medical disorder and a section describing staging criteria used with the disorder (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the follow up section, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 45 (new), Campbell, Dahlin, and Tetrault teach the template of claim 36.

Tetrault teaches a template in combination with a plurality of additional templates, the combination comprising a pad of a plurality of different templates (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the plurality of different templates, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

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Response to Arguments

10. Applicant's arguments filed September 16, 2010 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed September 16, 2010.

11. The Examiner has applied new prior art to the amended claims, therefore, the Applicant's arguments are moot.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 3:30 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on 571-272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. K. R./

Examiner, Art Unit 3626

/C. Luke Gilligan/

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Primary Examiner, Art Unit 3626